



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/576,357

04/19/2006

Anton Bleikolm

5829

9481

26936 7590 06/11/2008
SHOEMAKER AND MATTARE, LTD
10 POST OFFICE ROAD - SUITE 110
SILVER SPRING, MD 20910

EXAMINER

GRABOWSKI, KYLE ROBERT

ART UNIT

PAPER NUMBER

3725

MAIL DATE

DELIVERY MODE

06/11/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/576,357	BLEIKOLM ET AL.	
	Examiner	Art Unit	
	Kyle Grabowski	3725	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16, 18-25 and 27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16, 18-25 and 27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 January 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>01/29/08</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

The replacement drawings and amended specification now comply with 37 CFR 1.84(p)(4) and 37 CFR 1.84(p)(5).

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 16-22 and 24-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Plaschka et al. (US 7,040,663 B1).

In respect to claims 16-22, and 24, Plaschka et al. discloses a document of value such as a paper of value or ID card (Abstract) comprising: a first constituting part, substrate 1, and a second constituting part, security thread 2 (Fig. 1); substrate 1 includes a security element "print 4 produced with an inventive printing ink" (Col. 5, Lns 23-24) which "contains an optically variable material for example liquid-crystal pigments or interference layer pigments, as well as at least one machine-readable feature substance" (Col. 5, Lns 31-34). In one embodiment, "security thread 20 that, as already shown in FIG. 1, can be embedded in the bank note as a window security thread" (Col. 5, Lns 57-59), contains a optically variable layer 7 containing feature substance 8, (Fig. 2), which "may be executed as a printed layer" (Col. 5, Lns 62-63). Plaschka et al. also disclose covert infrared properties in the optically variable layers in which "the spectral response in the visible and infrared wave ranges can be evaluated to detect the optically variable material during machine testing" (Col. 3, Lns 52-54).

Although Plaschka et al. do not *explicitly* disclose the optically variable ink 4 (from the first embodiment, Fig. 1) and the security thread 20 containing an optically variable ink 4 (a second embodiment, Fig. 2) being used on the same banknote it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the security thread 20 with printed optically variable ink thereon in conjunction with the banknote containing the same optically variable ink 4 directly on its surface (Fig. 4) to utilize the security benefits of both embodiments while economically using only one type of material (i.e. the same optically variable ink). All of the claimed elements were known in prior art and one skilled in the art could have combined the

embodiments as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention. Plaschka et al. even state that security thread 20 “as already shown in FIG. 1, can be embedded in the bank note as a window security thread”. Furthermore, the embodiments are “materially” the same in that they “generally” perform the same security function.

In respect to claims 25-27, Plaschka et al. discloses all of the claimed subject matter for the reasons stated above including, inherently disclosing applying each security element having the same identifying properties, naturally allowing a comparison in their properties as a third feature.

4. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Plaschka et al. (US 7,040,663 B1) in view of Norman (US 5,478,629). Plaschka et al. discloses substantially all of the claimed subject matter except alternating polymer and coating layers comprising the substrate. Norman discloses an alternating polymer/coating multilayer sheet 10, comprising thick polymeric core layer 12 with laminate coatings 14 on each side (Fig. 1).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to provide the security substrate taught in an obvious combination of embodiments Plaschka et al. with an alternating coating-polymer-coating structure in view of Norman to provide high flexural durability to the ID card or another document of value.

Response to Arguments

5. Applicant's arguments with respect to claims 16-27 have been considered but are moot in view of the new ground(s) of rejection.

The examiner concedes that no single embodiment of Plaschka et al. alone anticipates the security ink 4 (Fig. 1) and security thread 20 (Fig. 2) used together on the same banknote.

The combination of the first and second embodiments, however, is obvious for the reasons stated above.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 3725

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kyle Grabowski whose telephone number is (571)270-3518. The examiner can normally be reached on Monday-Thursday, every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (571)272-4419. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Derris H Banks/
Supervisory Patent Examiner, Art Unit 3725

/Kyle Grabowski/
Examiner, Art Unit 3725